

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

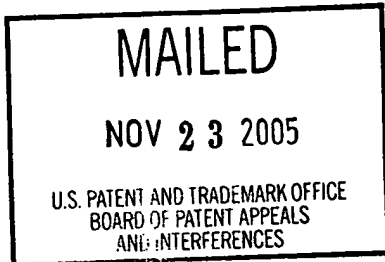
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Ex parte ROBERT S. BOSKO

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Application 10/045,301

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences (BPAI) on October 7, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matter(s) requiring attention prior to docketing are identified below:

Appellant filed an Appeal Brief on February 22, 2005. The examiner mailed an Examiner's Answer on June 16, 2005. Neither the brief nor the answer is in full compliance with the new rules under 37 CFR § 41.37 effective September 13, 2005.

In reference to the brief, the new rules as per 37 CFR § 41.37(c) states in part::

(c)(1) The brief will contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

...

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following section headings are missing from the Appeal Brief filed February 22, 2005:

- 1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

A supplemental brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website [www.uspto.gov](http://www.uspto.gov), and, in particular, the web page entitled "More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL: [www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

Also, a revised examiner's answer that corresponds to the § 41.37(c) is required. For the required content in an Examiner's answer under the new rules. The examiner is directed to the Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005) which states in part:

Briefs must comply with 37 CFR [§] 41.37, and all examiner's answers filed in response to such must comply with the guidelines set forth below.

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...  
(7) *Claims Appendix*. A Statement of whether the copy of the appealed claims contained in the appendix to the brief is correct and, if not, a correct copy of any incorrect claim.

...  
(8) *Evidence Relied Upon*. A listing of the evidence relied on (e-g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages. [Note: replaces previous heading "Prior Art of Record"]

...  
(11) *Related Proceedings Appendix*. Copies of any decisions rendered by a court or the Board in any proceeding identified by the examiner in the "Related Appeals and Interferences" section of the answer.

The headings listed above are missing from the examiner's answer. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) to hold the Appeal Brief filed February 22, 2005, defective and notification to appellants to file a supplemental Appeal Brief in full compliance with 37 CFR § 41.37;


2) for consideration of the substitute Appeal Brief, to vacate the Examiner's Answer mailed June 16, 2005, and issue a revised Examiner's Answer in accordance

Application 10/045,301

with the new rules effective September 13, 2004 (i.e., containing the missing headings noted above); and

3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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CF/vsh

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